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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,016	08/25/2000	John P. Wesson	60.469-021	6134

26584 7590 02/12/2003

OTIS ELEVATOR COMPANY
INTELLECTUAL PROPERTY DEPARTMENT
10 FARM SPRINGS
FARMINGTON, CT 06032

EXAMINER

TRAN, THUY VAN

ART UNIT	PAPER NUMBER
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3652

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ROUTING FOR DECISIONS OF BOARD OF APPEAL

	Initials	Date
QAS	<u>MB</u>	<u>12/01/03</u>
Director	<u>[Signature]</u>	<u>12/01/03</u>
SPE	_____	_____
Examiner	_____	_____
Disposal Recorded by LIE	_____	_____

Date of Decision	Serial Number	Examiner	Art Unit	Affirmed	Reversed
<u>11/21/03</u>	<u>09/648,016</u>	<u>TRAN</u>	<u>3652</u>	<input type="checkbox"/> 101	<input type="checkbox"/> 101
				<input type="checkbox"/> 102	<input checked="" type="checkbox"/> 102
				<input type="checkbox"/> 103	<input checked="" type="checkbox"/> 103
				<input type="checkbox"/> 112	<input checked="" type="checkbox"/> 112
				<input type="checkbox"/> other	<input type="checkbox"/> other

****DUE DATE: Jan. 05, 2004

Comments:

prior art does not meet claimed invention



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 11

Application Number: 09/688,016

Filing Date: 08/25/00

Appellant(s): Otis Elevator Company

MAILED

FEB 12 2003

GROUP 3600

David J. Gaskey

For Appellant

Art Unit: 3652

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 18, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because the originally filed specification discloses the resilient track includes different friction characteristics, not surface characteristics as stated in the brief.

Art Unit: 3652

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 13-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,655,626	Spiess	8-1997
5,852,897	Sukale	12-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 13 and 16-21 are rejected under 35 U.S.C. 112, second paragraph. This rejection is set forth in prior Office Action, Paper No. 6.

Claims 13-16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Spiess 5,655,626. This rejection is set forth in prior Office Action, Paper No. 6.

Claims 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spiess 5,655,626. This rejection is set forth in prior Office Action, Paper No. 6.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spiess in view of 5,852,897. This rejection is set forth in prior Office Action, Paper No. 6.

Art Unit: 3652

(11) Response to Argument

Appellants argue that the term “surface characteristics” is clearly understood in light of the specification and the claims. The originally filed specification discloses a track having different friction characteristics (see page 3, line 22 and page 4, line 22), not surface characteristics. In other words, it is not clear whether the surface characteristics are different in structural, materials, or frictional. Therefore, the originally filed specification fails to disclose or support what “surface characteristics” mean in the claimed invention.

In response to Appellants’ argument with respect to claims 13-15 that Spiess reference does not disclose a resilient track having different surface characteristics. Spiess discloses in column 4, lines 6-9 that these hard unsprung at-rest zones 26 can be produced by mounting different fillings as per Fig. 2a or by varying the filling pressure via plunger 21 as per Fig. 2b. By varying the filling pressure means different surface characteristics. Thus, providing different friction surface characteristics between the outer ends and the middle portion.

Re claim 16, Appellants argue that Spiess does not show or suggest a track having multiple pieces where different materials are used for different pieces. As broadly claimed, Spiess in Figure 2c and column 4, lines 1-9 discloses the track having a multiple pieces, a first piece (26) of one material having the first characteristic and a second piece (middle portion) of a second material.

Re claims 17 and 18, Appellants argue that it would not be obvious to substitute one of the material cited in the claimed limitation for the steel tube (4) of Spiess. However, the track 3 of Fig. 2a is not a steel track.

Art Unit: 3652

Re claim 19, in response to applicant's argument that there is no suggestion to combine the Spiess and Sukale references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the drive system of Sukale for the door assembly of Spiess in order to provide a simple and compact friction wheel drive for the sliding door assembly.

Re claim 20, Appellants argue that Spiess does not suggest an arrangement where independent portions are used for a track. Claim 20 would be rejected under 35 U.S.C. 102 (b) if Spiess shown or suggested independent portions track.

Re claim 21, Appellants argue that Spiess does not show or suggest the claim limitation. As stated above, Spiess discloses in Fig. 2c and column 4, line 1-9 that the first surface characteristic is near each end of the track.

Art Unit: 3652

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

February 10, 2003

Conferees

TVT (TVT)

JK

EDL